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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/900,503      | 07/06/2001  | Lawrence W. Hu       | GUID012CON          | 5237             |

7590 12/13/2001

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EXAMINER

SMITH, JEFFREY A

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 12/13/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |              |  |
|------------------------------|------------------|--------------|--|
| <b>Office Action Summary</b> | Application No.  | Applicant(s) |  |
|                              | 09/900,503       | HU ET AL.    |  |
|                              | Examiner         | Art Unit     |  |
|                              | Jeffrey A. Smith | 3732         |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                 | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: ____                                     |

**DETAILED ACTION**

***Specification***

✓ The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Particularly, Applicant's assistance in ensuring the proper cross-correspondence of the reference numerals in the specification and drawings is requested.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentile (FR 473,451 A) in view of Brief (U.S. Patent No. 4,747,395).

Gentile discloses (Fig. 2) a retractor blade (4) attached to a drive mechanism (7). The blade comprises a body having a first end (adjacent "9" in Fig. 4), a second end (opposite "9" in Fig. 4), and a channel (best observed in Fig. 1) adapted to engage one side of an incision in a patient. The first end has a first cavity (seen adjacent "9" in Fig. 5) which receives a support member (8: Fig. 5) extending from said drive mechanism.

The first cavity is a blind hole having a predetermined depth from the first end (as seen in Fig. 5).

The blind hole is substantially cylindrical which can be gleaned by virtue of the blade's depicted rotation about the support member in Fig. 3.

Gentile does not disclose a polymeric body. Brief, in a similar blade (col. 1, lines 4-7), discloses the use of polymeric material. It would have been obvious to one of ordinary skill in the art to have provided the body of Gentile to have comprised a polymeric material because of its known chemical inertness, compatibility with cell metabolism and ability to withstand repeated sterilizations (col. 2, lines 48-57).

The combination of Gentile and Brief does not provide specifics regarding the dept of the blind hole. However, to have specified a particular range of dimensions for such depth

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would have been an obvious matter of design choice to the skilled artisan and would not have otherwise affected the operation of the combination proposed. Applicant has not persuasively demonstrated that such range is of particular criticality or that it is anything other than one of numerous ranges that the skilled artisan would have found obvious for performing the function of the Gentile blade as modified. In re Rose, 105 USPQ 237 (CCPA 1955).

The combination of Gentile and Brief does not provide that said first cavity becomes progressively smaller in a direction away from said first end. However, to have modified the combination of Gentile and Brief to have included such feature would have been nothing more than one of numerous configurations a person of ordinary skill in the art would have found obvious for the purpose of providing the rotateable cooperative engagement between the blade and the support member already disclosed by Gentile. In re Dailey, 149 USPQ 47 (CCPA 1976).

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santilli et al. (U.S. Patent No. 6,099,468) in view of Brief (U.S. Patent No. 4,747,395).

Santilli et al. discloses (Fig. 1) a retractor blade (14) attached to a drive mechanism (28). The retractor blade

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comprises a body having a first end (adjacent "28" in Fig. 1), a second end (adjacent "14" in Fig. 1), a channel (best seen in Fig. 3) adapted to engage on side of an incision in a patient (shown in Fig. 2), and a rail (32) extending along at least a portion of the body (shown in Fig. 1).

Santilli et al. further discloses a plurality of open slots ("spaces between adjacent coils": col. 4, lines 24-30) for receiving a suture therein.

Santilli et al. does not disclose a polymeric body. Brief, in a similar blade (col. 1, lines 4-7), discloses the use of polymeric material. It would have been obvious to one of ordinary skill in the art to have provided the body of Santilli et al. to have comprised a polymeric material because of its known chemical inertness, compatibility with cell metabolism and ability to withstand repeated sterilizations (col. 2, lines 48-57).

#### ***Allowable Subject Matter***

Claims 7, 9, and 11-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are rejected under the judicially created doctrine of double patenting over claims 1-39 of U. S. Patent No. 6,283,912 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which

matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The additional references cited disclose various features which are similar to those disclosed by Applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is 703-308-3588. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas D. Lucchesi can be reached on 703-308-2698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

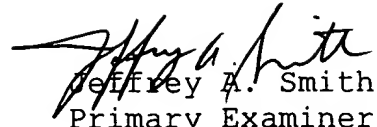
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



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Jeffrey A. Smith  
Primary Examiner  
Art Unit 3732

jas  
December 9, 2001